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IN THE
Supreme Court of the United States

October Term, 1967
No. 1303

LEAR, INCORPORATED,

Petitioner,

vs.

JOHN S. ADKINS,

Respondent.

Reply Brief of Petitioner in Support of Petition for
a Writ of Certiorari (Filed April 9, 1968).

Introduction.

The brief of Respondent Adkins, filed in opposition to Lear's Petition, confuses the issues involved in this case. It sets forth an unnecessarily detailed restatement of the facts; it revises the Questions Presented, as stated in the Petition; and it then urges that these revised questions were not duly raised or preserved by Petitioner in the courts below and are not such as to justify review by this Court.

This Reply Brief will be directed primarily to showing that (a) to the extent that Respondent's revised questions raise new issues, they are immaterial, and (b) to the extent that Respondent's revised questions merely rephrase the questions presented by Petitioner, they were duly raised and preserved by Petitioner below and call for review by this Court.

However, we cannot ignore and therefore shall first comment briefly on the unwarranted sweeping charge made in Respondent's brief (R. Br. p. 9)¹ that the statement of the case in the Petition did not fairly or accurately set forth the material facts. The Brief seeks to support this charge by specific reference to certain matters, such as Adkins' employment in 1951, the extent to which gyros were sold to the military, and the independent development of the steel gyros in Grand Rapids, Michigan.

The failure of the Petition to mention that Adkins had other employment for a few months after he left the Air Force before he came to work for Lear is obviously immaterial. On the other hand, the irresponsibility of Respondent's charge of Petitioner's inaccuracy is demonstrated by his statement that the record does not show the extent of sales of gyros by Lear to the military. (R. Br. p. 14.) On the contrary, in its rulings on Lear's motion for judgment notwithstanding the verdict, the Superior Court stated, after reviewing the coded information as to sales furnished by Lear, that Lear's products were not put on the public market—*i.e.*, were all sold to the Government. (A, p. 95.)

As to Adkins' challenge of the Petitioner's statement (R. Br. p. 11) that the steel gyros were not independently developed in Grand Rapids, Michigan, reference need be made only to the fact that the claims of the patent are limited to supporting apparatus for the bearings, and also to the fact that Adkins testified twice, unequivocally, that he had nothing to do with

¹Brief for Respondent in Opposition cited herein as "R. Br. p.".

the design or development of the configuration of such apparatus of the steel gyros [R. T. pp. 550-552, 1709-1711, 2085-2088]. Furthermore, the man responsible for the project in Michigan testified that the Michigan steel gyros were developed independently. [R. T. pp. 1718, 1743-1744, 1754-1756, 1788.]

Further irresponsibility in Respondent's restatement of the case is found in the implication that Adkins' compensation consisted exclusively of such royalties as might be paid him, based on his ideas, discoveries and inventions; whereas, in fact, Adkins was an employee who was paid a substantial salary with bonuses, like other contemporary professional employees. [C. T. pp. 1497-1508, R. T. 212 and 213, 238-FF; C, p. 141.]

Respondent's revised questions, and Respondent's brief, do not deal at all with the issues presented by Question Three of the Petition and Respondent's fifth question raises an irrelevant issue which was not raised by any of the questions present in the Petition. Accordingly, as an aid in our discussion of Respondent's brief, we have shown the relationship of Respondent's revised questions to the Questions Presented in the Petition by setting them forth comparatively in Appendix O, annexed to this Reply Brief. It is unnecessary to discuss these revised questions to the extent that they raise issues not involved in the Questions Presented by Petitioner. We shall, however, discuss briefly certain arguments made in the Respondent's Brief with respect to the revised questions, insofar as by these arguments Respondent seeks to show that the Questions Presented in the Petition were not duly raised below or do not warrant review by this Court.

As shown by Appendix O, the Questions Presented in the Petition and Respondent's revised questions may be grouped as follows:

- A. General Limitations on the Application of Licensee Estoppel.
- B. Limitations on the Application of Licensee Estoppel Under a License Agreement Containing Provisions in Restraint of Trade.
- C. Restrictive Conditions in a License Agreement as a Patent Misuse.
- D. Applicability of Basic Criteria of Federal Patent Law in Enforcing a Patent Under a License Agreement.

We shall follow this grouping in this Reply Brief.

A. General Limitations on the Application of Licensee Estoppel.

Questions One and Two in the Petition involve the circumstances under which licensee estoppel should be inapplicable, apart from any infirmity in the license agreement based upon restrictive provisions repugnant to the antitrust laws. In any suit for royalties under a license agreement, any estoppel of the licensee to challenge the validity of the licensor's patent will, as in this case, be a determinative issue.

Thus, although Respondent's patent had been held invalid by the Superior Court, the California Supreme Court nevertheless held that validity was completely irrelevant, and acknowledged no limitations whatsoever on the estoppel of any licensee to challenge the validity of the licensor's patent. Respondent's statement (R. Br. pp. 2-3) that the Court would undoubtedly have held

Adkin's patent valid is supported only by a short excerpt from the Court's opinion directed to the narrow question whether Lear's products followed the prior art exactly. On the other hand the Superior Court considered validity in detail, and, after reviewing the record and the decisions of this Court and the federal courts, held that the patent was unquestionably invalid.

Question One has been revised by Respondent, as shown by Appendix O, into two separate questions, namely, the first and third "restated" questions in the Respondent's brief.

The first question of Respondent's brief is nothing more than a restatement of the general principle of licensee estoppel where the circumstances of the case do not make application of the principle inappropriate. As Respondent points out (R. Br. p. 6), Lear has recognized in the District Court of Appeal and in the California Supreme Court that under general principles of law, *only* so long as the licensee is "operating under the license", the licensee is estopped to contest the validity of the licensed patent, where the patent was in existence at the time of granting of the license.

Lear's recognition of the application of this general principle of estoppel where the licensee is accepting the benefits of a patent monopoly and operating under a license agreement does not, contrary to Adkins' statement, constitute an abandonment of Lear's contention that licensee estoppel has limited application and is inapplicable in many circumstances. Under Question One of the Petition, Lear challenges the applicability of estoppel where the licensee has stood out from under the license agreement and has refused to be bound by it in view of non-patentability of the claims of the ap-

plication and invalidity of the patent. By standing out from under a license agreement, a licensee subjects himself to a suit for infringement at the election of the licensor. Additionally, the licensee places the patentability of the claims and the validity of the patent in issue. This is especially true where the license agreement conditions the payment of royalties on the use of a "patentable" invention, as the license agreement does in the present case.

Under Question Two in the Petition, Lear challenges the applicability of estoppel where the license is under a patent application and a patent issues thereafter with new claims.

As shown by Appendix O, Respondent, in his revised "restatement" (fourth question) of Question Two of the Petition, erroneously narrows the scope of the issues raised by Question Two so as to exclude from consideration the important question whether a licensee under a patent application may be estopped from challenging the patentability of the claims of the application, regardless of the subsequent issuance of a patent. As pointed out in the Petition (Petition, pp. 27, 28), this Court's decision in *Westinghouse Electric & Mfg. Co. v. Formica Insulation Company* (1924), 266 U.S. 342, has properly caused the lower federal courts to question whether the licensee under a patent application should be precluded from challenging the patentability of the claims of the application. *Baldwin Rubber Co. v. Paine & Williams Co.* (6th Cir., 1939), 107 F. 2d 350; *Stubnitz-Greene Spring Corporation v. Fort Pitt Bedding Co.* (6th Cir., 1940), 110 F. 2d 192.

Whether or not a licensee is estopped to contest patentability and validity is a federal question. *Jurisdiction*

of the Supreme Court of the United States, Wolfson and Kurland, ed. 1951, p. 747. No particular tag or form of words is required to label these issues as federal questions. *New York Ex Rel. Bryant v. Zimmerman* (1928), 278 U.S. 63, 67.

Adkins asserts (R. Br. p. 26) that estoppel is purely a question of state law. This Court has clearly held to the contrary. In *MacGregor v. Westinghouse Elec. & Mfg. Co.* (1947), 329 U.S. 402, 407, this Court stated:

“ . . . Since MacGregor invoked federal law to sustain his challenge to the validity of the patent, the alleged misuse of the patent, and the price-fixing covenant, his contentions raised federal questions not governed by state estoppel or contract severability rules.”

As pointed out in the Petition, throughout the appellate proceedings in the California courts, Lear challenged the patentability of the claims of Adkins' application for patent and the validity of Adkins' subsequently-issued patent. (Petition, pp. 10-17.) Furthermore, in response to Adkins' assertion that Lear was estopped to challenge patentability and validity, Lear, throughout the proceedings, denied that it was so estopped. (Petition, pp. 11-16.)

Estoppel was expressly ruled upon by the Superior Court (A, p. 94), by the District Court of Appeal (A, p. 70), and by the Supreme Court of the State of California. (A. p. 28.) Thus, the federal questions of estoppel to contest patentability and validity were expressly considered by all three of the California courts.

Where the highest state court expressly considers and determines federal issues, such as the issues pre-

sented by Questions One and Two of the Petition, it is conclusive that the federal questions were properly raised and preserved. *Raley v. Ohio* (1959), 360 U.S. 423; *Charleston Federal Savings & Loan Ass'n. v. Alderson* (1945), 324 U.S. 182; *Saltonstall v. Saltonstall* (1928), 276 U.S. 260; *Whitney v. California* (1927), 274 U.S. 357; *Manhattan Life Ins. Co. v. Cohen* (1914), 234 U.S. 123.

The Respondent challenges not only the raising below of the federal questions which concern the general applicability of estoppel, but also urges, in Points 1 and 3 of the Argument of his Brief, that these questions are without sufficient importance to justify review or have already been resolved by this Court contrary to the position taken by Petitioner.

The substantive importance and lack of clear prior determination by this Court of the issues of federal law presented by Questions One and Two of the Petition are fully supported in the Petition. However, it is appropriate to comment on certain cases relied on by Respondent which were not referred to in the Petition.

The case of *St. Paul Plow Works v. Starling* (1891), 140 U.S. 184, is greatly relied on by Respondent as establishing that a licensee is estopped to repudiate and stand out from under a license agreement on the ground of patent invalidity. (R. Br. pp. 27, 28.) That case did not so hold. On the contrary, although it was held, absent a specific termination provision, that the license was granted for the life of the patent, this Court nevertheless approved the action of the lower court in examining issues of novelty and patentability in order

to determine the validity of the licensor's patent in view of the prior art patents. The fact that the Court considered these issues shows that in fact estoppel was not applied.

Furthermore, the Respondent urges that *Bowers Mfg. Co. v. All-Steel Equipment Co., Inc.* (9th Cir. 1960), 275 F. 2d 809, indicates that, although it may be that a licensee under an exclusive license, is not estopped to challenge the validity of his licensor's patent, a non-exclusive licensee is so estopped. However, Respondent ignores the fact that at the time Petitioner first challenged the patentability of the claims in Respondent's application, its license was exclusive. Furthermore, the opinion of the Court of Appeals in *Bowers* recognizes that at least under some circumstances other federal courts do not estop even a non-exclusive licensee from challenging patent validity, citing *Viki Hosiery Corp. v. Margulies* (E.D.Pa. 1958), 164 F. Supp. 738, and *Universal Rim Co. v. Scott* (N.D.Ohio, 1922), 21 F. 2d 346. The relevance of the decision in *Bowers* is most dubious, in view of the nature of the license there involved, which license primarily granted immunity from an infringement suit. However, the court's opinion is significant in its recognition of the divergence of opinion in the lower federal courts as to the extent and applicability of licensee estoppel. Such divergence emphasizes need for clarification by this Court of that important question for the benefit of the federal as well as the state courts.

B. Limitations on the Application of Licensee Estoppel Under a License Agreement Containing Provisions in Restraint of Trade.

As shown in Appendix O, Question Four of the Petition relates to limitations on the application of licensee estoppel where a license agreement contains provisions in restraint of trade. Adkins' newly-formulated second question purports to "restate" Question Four of the Petition (R. Br. p. 6). However, Adkins has so altered this question that it is now completely different from Question Four. On the one hand, Question Four is concerned with a requirement of the license agreement, as interpreted by the California Supreme Court, that the licensee must cease manufacturing certain products in order to terminate the license agreement, irrespective of the validity of the licensor's patent rights. On the other hand, Adkins' second question deals solely with a normal provision of any license agreement which requires payment of royalties where the licensee manufactures devices covered by the patent.

Since Lear never urged that, in the absence of a valid patent, a license provision requiring payment of royalties is in restraint of trade, it did not raise below Adkins' second question. As pointed out in the Petition, however, Lear did urge, when the California Supreme Court included the requirement in construing the agreement, that since the inclusion in a license agreement of a requirement that a licensee must cease manufacturing its products in order to terminate the license agreement is unlawful in the absence of a valid patent; the licensee under such an agreement should not be estopped to challenge the validity of the patent. (Petition, pp. 18-19.)

Adkins recognizes the difference, from the standpoint of restraint of trade, between these two types of undertakings, in stating at page 25 of his Brief:

“... Obviously, there is material distinction between an agreement not to manufacture or sell devices covered by a patent and a license agreement to pay a royalty if the defendant does manufacture and sell devices covered by the patent. The former is a restraint, the latter is not.”

What Adkins fails to recognize is the substantial identity of an agreement by a non-licensee not to manufacture devices covered by a patent and of an agreement by a licensee that he will have to cease manufacturing devices in order to terminate the license agreement, with the implied proviso that the licensee will not thereafter manufacture these devices. The necessity of a valid patent to “rescue” the former undertaking, as an illegal restraint of trade, “from the jaws of the anti-trust laws”, was recognized in Judge Frank’s opinion in the case of *Nachman Spring-Filled Corporation v. Kay Mfg. Co.* (2nd Cir. 1943), 139 F. 2d 781, 784. There is equal necessity for patent validity in order similarly to “rescue” a license agreement under which a licensee must cease manufacturing products covered by the licensed patent to terminate the agreement, which cessation must impliedly continue thereafter. Any application of licensee estoppel under such a license agreement would sanction the very unlawful restraint which was condemned by Judge Frank in the *Nachman* case, p. 784, as coming within the rationale of this Court’s decision in the case of *Sola Electric Company v. Jefferson Electric Company* (1942), 317 U.S. 173. Similar restraints have been condemned by this Court in subsequent decisions. (Petition, p. 31).

C. Restrictive Conditions in a License Agreement as a Patent Misuse.

As shown in Appendix O; Question Three of the Petition raises the issue whether there is an unlawful extension of a patent monopoly where a license agreement requires that a licensee cease manufacturing a product in order to terminate the agreement, even though termination is effected prior to the issuance of any patent at a time when the licensor has no protectible property rights, and irrespective of the validity of the subsequently-issued patent.

Adkins asserts that Question Three and Question Four are identical. (R. Br. p. 5.) This is not so, even though both questions stem from the same requirement of the license agreement. Question Three is concerned with a misuse of patent rights resulting from an extension of the patent monopoly, while Question Four is concerned with the inapplicability of licensee estoppel where there is a restraint of trade.

The consequences of a determination under Questions Three and Four are quite different. If there is a misuse of patent rights, the license agreement is unenforceable, regardless of patent validity. If there is a restraint of trade which is permissible only if there is a valid patent, licensee estoppel is inapplicable but the licensee is relieved from his obligations under the license agreement only if the patent is then shown to be invalid.

Adkins does not discuss Question Three, but would substitute his fifth question, raising an issue which is not in controversy. That is whether it is a violation of the antitrust laws for a license agreement to contain a provision calling for the payment of royalties during

the pendency of the application. It is quite another question whether a license agreement may validly require that, in order to terminate the agreement, the licensee must cease the manufacture of products begun before the execution of the agreement, even though at the time of termination the licensor has no patent and no protectible property rights under the federal patent laws.

The federal courts have not specifically considered whether there is an unlawful extension of the patent monopoly where such a condition on termination is imposed in a license granted under a pending patent application. However, any such condition, if enforced, would result, in substance, in an extension of the patent monopoly to cover the period prior to issuance of any patent, and would run counter to the principles set forth by this Court in the case of *Brulotte v. Thys Co.* (1964), 379 U.S. 29, where extension of the monopoly was sought to be accomplished by agreement of the parties, and in the case of *Sears, Roebuck & Co. v. Stiffel Co.* (1964), 376 U.S. 225, and *Compco Corp. v. Day-Brite Lighting, Inc.* (1964), 376 U.S. 234, where such extension was sought to be accomplished by application of state law.

D. Applicability of Basic Criteria of Federal Patent Law in Enforcing a Patent Under a License Agreement.

Question Five of the Petition presents the broad basic issue as to whether a state court in enforcing a patent under a license agreement may ignore the basic criteria of federal patent law relating to procurement and interpretation of the scope of the patent which would be required to be applied in the enforcement of the patent in an infringement action.

As shown in Appendix O, Adkins has avoided discussion of the basic issue of Question Five by addressing himself, in his newly-formulated sixth and seventh questions, only to the validity of the California Supreme Court's conclusions with respect to certain specific aspects of Adkins' patent. Thus the Respondent's Brief ignores the court's unequivocal statement that it was "not concerned with defenses which might be available to Lear in the determination of questions of validity and infringement" (A, p. 46), as well as the court's refusal, consistently with its disregard of such defenses, to consider Lear's allegations of fraud on the Patent Office (footnote 35, A, p. 46.)

Respondent's Brief similarly fails to recognize the California Supreme Court's refusal to consider Lear's claim that Adkins improperly added new matter to his application. Early in its opinion, the court stated that whether or not new matter was added was not relevant on the issue of termination. (Footnote 19, A, p. 21.) Later in its opinion, when the court construed the scope of Adkins' patent, it stated that the patented apparatus fell within the scope of the initial application. (A, p. 34.) However, in construing the scope of the patent, the court relied heavily upon language (A, p. 32) which had been added to the specifications of the application by amendment [Ex. P, pp. 59-60] some four years after the application was filed, without giving any consideration to the question whether such language added new matter to the specifications. In effect, the court con-

strued the scope of the initial application to include everything in the specifications which appears in the printed patent, without considering whether the specifications had been enlarged to encompass subsequently-developed apparatus.

Furthermore, although in discussing his seventh question the Respondent (R. Br. p. 34) quotes the text of lip-service given by the California Supreme Court to the doctrine of file wrapper estoppel enunciated by this Court in the case of *Schriber-Schroth Co. v. Cleveland Trust Co.* (1940), 311 U.S. 211, he earlier admits that as to the claims which issued in Adkins' patent "the Court [the California Supreme Court] held . . . that the doctrine of file wrapper estoppel was inapplicable." (R. Br. p. 18.) The reason given by the court for not applying this doctrine was that the claims of the patent were new claims. (A, pp. 33, 34.) However, this is in direct derogation of the doctrine, since these claims were added to the application more than five years after it was filed and after numerous earlier claims had been rejected and abandoned.

It is obviously not within the proper scope of this Petition to challenge the validity of the state court's conclusions with respect to specific factors bearing on the validity or proper scope of Adkins' patent. On the other hand, we respectfully urge that it is necessary and proper to bring before this Court the general question whether the criteria of federal patent law which are relevant in an infringement suit may be ignored by

a state court in an action which seeks to enforce a patent under a license agreement.

Conclusion.

This case manifestly involves important federal questions not heretofore determined by this Court, on which guidance should be provided to both state and federal courts. In addition, the California Supreme Court has decided substantial federal questions in a manner inconsistent with applicable decisions of this Court.

Accordingly, we respectfully submit that Lear's Petition for a Writ of Certiorari should be granted.

Dated: May 13, 1968.

C. RUSSELL HALE,
EDWIN L. HARTZ,
THOMAS G. CORCORAN,
ALLEN E. THROOP,

Attorneys for Petitioner.

CORCORAN, FOLEY, YOUNGMAN & ROWE,
CHRISTIE, PARKER & HALE,
Of Counsel.

APPENDIX O.

Comparison of Questions Presented in Petition and Revised Questions Presented in Respondent's Brief in Opposition.

A. General Limitations on the Application of Licensee Estoppel.

Questions in the Petition

1. Whether it is contrary to the purposes and provisions of the federal patent and antitrust laws for a licensee to be estopped from challenging the validity of the licensor's patent,

particularly where the licensee has stood out from under the license agreement by notifying the licensor that he refuses to be bound by the agreement, and by asserting failure of consideration because of non-patentability of the invention and invalidity of the patent.

Respondent's Revised Questions

1. Whether the doctrine that a licensee is estopped to contest the validity of his licensor's patent, absent any misuse of the patent, is contrary to the Federal patent statutes.

3. Whether a licensee may always repudiate and stand out from under the license agreement and then contest the validity of the patent on the theory that if the patent is invalid the consideration for the license agreement fails.

2. Whether it is contrary to the purposes and provisions of the federal patent and antitrust laws for a licensee under an application for patent to be estopped from challenging the patentability of the claims before any patent issues or from challenging the validity of a patent which subsequently issues.

4. Whether the doctrine that a licensee is estopped to contest the validity of his licensor's patent is any different where the license is initially under a patent application and then shifts to a license under the claims of the issued patent.

**B. Limitations on the Application of Licensee Estoppel
Under a License Agreement Containing Provisions in
Restraint of Trade.**

Questions in the Petition

4. Whether it is contrary to the purposes and provisions of the federal patent and antitrust laws for a licensee to be estopped from challenging the validity of the licensor's patent where there is included in the license agreement, as interpreted by a state court, a provision which, in the absence of a valid patent, is in restraint of trade and unenforceable.

*Respondent's Revised
Questions*

2. Whether the doctrine that a licensee is estopped to contest the validity of his licensor's patent is contrary to the Sherman Act where the license agreement provides that the licensee must pay royalties where he manufactures devices covered by the patent.

C. Restrictive Conditions in a License Agreement as a Patent Misuse.

Questions in the Petition

3. Whether it is a misuse of patent rights or an anti-trust violation to include in a license agreement, as interpreted by a state court, a provision which extends the monopoly of a patent by conditioning the right of the licensee to terminate the license, either before or after the patent issues, on the cessation of manufacture of the products purportedly covered by the license.

Respondent's Revised Questions

Note: Although Respondent's revised fifth question does not involve any restrictive condition, it is shown below since it purports to restate Question Three in the Petition.

5. Whether the license agreement violates either the patent laws or the Sherman Act by requiring the licensee to pay royalties during the pendency of the patent application.

D. Applicability of Basic Criteria of Federal Patent Law in Enforcing a Patent Under a License Agreement.

Questions in the Petition

5. Whether it is an unlawful extension of the patent monopoly and contrary to the purposes and provisions of the federal patent and antitrust laws for a state court, in enforcing a patent under a license agreement, to ignore those basic criteria of federal patent law relating to procurement of the patent and to the interpretation of its scope which are required to be applied in the enforcement of the patent.

Respondent's Revised Questions

Note: Although Respondents' sixth and seventh questions do not challenge the applicability of the basic criteria of federal patent law, they are shown below since they purport to be responsive to Question Five in the Petition.

6. Whether Adkins inserted any new matter in the specifications, and, if so, whether or not this constitutes fraud on the Patent Office precluding recovery, in a State court, of royalties due under a license agreement.

7. Whether the California Supreme Court, after properly stating the doctrine of file wrapper estoppel, correctly applied it to the facts in this case.